UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,639	02/21/2002	Paul A. Cronce	2401CIP	9753

57580 7590 08/11/2009
VIRTUAL LAW PARTNERS LLP
P.O. BOX 1329
MOUNTAIN VIEW, CA 94042

EXAMINER	
FISCHER, ANDREW J	

ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
08/11/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@virtuallawpartners.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL A. CRONCE

Appeal 2009-002344
Application 10/080,639
Technology Center 3600

Decided: August 7, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges.*

MOHANTY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-14 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed the delivery of a licensed toolset to a software publisher for creating license-managed software products. The method comprises providing an authorization process for both a toolset publisher and related toolset and a software publisher and related software product. When an authorization program is invoked, the authorization program obtains a license for controlling the use of the software program (Spec. 4:14-5:2). Claim 1, reproduced below, is representative of the subject matter of appeal.

> 1. A method for delivery of a license-managed toolset for creating a license-managed software product, the method comprising the step of:
>
> (a) providing an authorization process, the authorization process including the steps of:
>
> (i) creating a first public and private key pair for a software publisher,
>
> (ii) creating a second public and private key pair for a software program, wherein at least one of the second private and public keys is digitally signed by the first private key of the software publisher,

(iii) creating an authorization program for the software program, and embedding a copy of the first and second public keys in the authorization program,

(iv) combining the authorization program with a software program, such that when the software program is invoked on a computer, the authorization program obtains a license for the software program by:

(1) creating a license request,

(2) encrypting the license request using the second public key,

(3) transmitting the encrypted license request to a key authority,

(4) receiving an encrypted license from the key authority, wherein the license includes license terms, and

(5) decrypting the license using the first public key, such that the license terms are used to control use of the software program;

(b) implementing the authorization process in a software toolset that is provided by a toolset publisher, wherein when the authorization process is invoked in the software toolset, the toolset publisher is the publisher in the authorization process and the software toolset is the software program in the authorization process, and

(c) implementing the authorization process in a software product that is provided by a publisher of the software product using the software toolset, wherein when the authorization process is invoked in the software product, the publisher of the software product is the publisher in the authorization process and the software product is the software program in the authorization process, whereby both the software toolset and the software product use the same authorization process to obtain respective licenses.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Venkatesan	US 6,898,706 B1	May 24, 2005

The following rejections are before us for review:

1. Claims 1-14 are rejected under 35 U.S.C. § 102(e) as anticipated by Venkatesan.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether Venkatesan discloses that "when the software program is invoked on the computer, the authorization program obtains a license for the software program by creating a license request."

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:[1]

FF1. Venkatesan discloses a cryptographic technique for digital rights management (Title). A large number of identical watermarks are embedded in a software object. The user downloads the software object and transacts with the publisher to obtain an electronic license signed by the publisher to an enforcer that is located in the client computer (Abstract).

---

[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Venkatesan discloses that once the user has downloaded the watermarked object that the user through his or her client PC electronically transacts through the Internet 30 and links to the publisher's web server. In return for payment the client PC is downloaded an electronic license L to an "enforcer" located in that PC (Col. 14:35-45).

FF3. Venkatesan in Col. 14:52-54 discloses that the enforcer has active objects such as executable programs and that the enforcer can reside on the operating system itself executing on the PC.

FF4. Venkatesan in Col. 14:52-54 does not disclose that when the software program is invoked that it obtains a license by creating a license request.

FF5. Venkatesan in Col. 20:9-14 does not disclose that the enforcer resides on the software program. Venkatesen discloses that the enforcer is located with the operating system of the PC (Col. 18:52-57, Fig. 4).

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

The Appellant argues that the rejection of claims 1 and 7 is improper because Venkatesan fails to disclose "combining the authorization program with a software program" and that "when the software program is invoked on a computer," the authorization program obtains a license for the software program as recited in the claims. The Appellant instead argues that in Venkatesan that "the user" initiates the license request (Br. 13-14). The Appellant also argues that in Venkatesan that the "enforcer that looks for watermarks" cannot be considered analogous to the authorization program because it does not generate a license request and is not part of the software object (Br. 14).

In contrast the Examiner has determined that Venkatesan does disclose the cited claim limitations. The Examiner has determined that the claims do not require automatic initiation of the license request without user interaction but that regardless that Venkatesan discloses this feature in Col. 14:52-54 (Ans. 10-11). The Examiner also has determined that the "enforcer" in Venkatesan is analogous to the claimed "authorization program" (Ans. 11).

We agree with the Appellant. Claim 1 specifically requires that "when the software program is invoked on the computer, the authorization program obtains a license for the software program by ... creating a license request". Thus, claim 1 requires that when the software program is invoked, the authorization program obtains a license by creating a license request. In contrast, Venkatesan discloses that once the user has downloaded the watermarked object, the user, through his or her client PC electronically transacts through the Internet 30 and links to the publisher's web server. In return for payment the client PC is downloaded an electronic license L to an

"enforcer" located in that PC (FF2). Venkatesan in Col. 14:52-54 does disclose that the enforcer has active objects such as executable programs (FF3). However this cited portion of Venkatesan (Col. 14:52-54) does not disclose when the software program is invoked that the authorization program obtains a license by creating a license request (FF4). Note that in Venkatesan it is the user that obtains the license (FF1) not the authorization program when the software program is invoked (FF4). For these reasons the rejection of claim 1 is not sustained. Claim 7 contains limitation similar to those in claim 1 and the rejection of this claim as well as dependent claims 2-6 and 8-14 is not sustained for the same reasons.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting Claims 1-14 under 35 U.S.C. § 102(e) as anticipated by Venkatesan.

DECISON

The Examiner's rejection of claims 1-14 is reversed.

REVERSED

MP

Virtual Law Partners LLP
P.O. Box 1329
Mountain View CA 94042